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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,144	04/12/2004	Heinz Focke	Q-80960	1171
23373	7590	03/08/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			SIPOS, JOHN	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/822,144	Applicant(s) FOCKE ET AL.	
	Examiner John Sipos	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/4/04</u> . | 6) <input type="checkbox"/> Other: ____. |

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

The following is a quotation of the second paragraph of 35 U.S.C. ' 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under **35 U.S.C. ' 112, second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The scope of the claims is indefinite due to the use of terms such as “in particular” (claims 1,3,9); “or the like” (claims 1,9); “pack insert – insert blank –” and “pack contents - cigarette block-“(claims 1,4,7,9,10,11); “(further)” (claim 3); “it being possible” (claim 9); “to be precise” (claim 10); “if appropriate” (claim 11); “preferably” (claim 12). Since these terms do not positively recite the intended element they do not provide proper antecedence to similar terms used in subsequent claims. For example, claim 1 recites “packs, in particular cigarette packs,” i.e. not necessarily cigarette packs, the use of the term “cigarette packs” in subsequent claims do not have proper antecedence. The claims should be reviewed and these terms should be deleted or positively recited.

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

The following is a quotation of the second paragraph of 35 U.S.C. ' 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. ' 112, **second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no proper antecedence for the "folding turret" of the claim.

REJECTIONS OF CLAIMS BASED ON PRIOR ART

The following is a quotation of 35 U.S.C. ' 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, to the extent that they are definite, are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Belcher (3,508,993). The patent to Belcher shows a process for labeling articles moved by a turret 14 by temporarily attaching the labels to the articles by electrostatic charging the articles with electrodes 62. It would have been obvious to one skilled in the art to charge the label instead of the article since the same relative charging and the same result would be accomplished. Regarding the specific article and as discussed in the above indefiniteness rejection, since the claims set forth "packs, in particular cigarette packs" this term is interpreted as any type of packs and not limited to cigarette packs.

Regarding claims 4,8,10 and 12, the location of the label on the article and the location of the charge is a matter of desired choice and it would have been obvious to one skilled in the art to place the insert in any position on the article since no new or unexpected result would be

achieved and the process /apparatus would perform equally well with the label being placed in any position on the article.

Regarding claims 3,5-7 and 11 the use of inserts, coupons, labels, booklets etc. in cigarette packs, both of the type where the insert is inserted into a partially formed pack or on a hinge-lid-type pack with a collar, and cigarette pack turrets are well known in the art (see admitted prior art on page 1 of the specification) and modifying the process/apparatus of Belcher to accommodate such packs would have been obvious to one skilled in the art.

Claims 1-12, to the extent that they are definite, are rejected under 35 U.S.C. ' 103(a) as being unpatentable over the patent to Draghetti (6,105,340) in view of Belcher (3,508,993) or Focke (6,138,437). The patent to Draghetti shows a cigarette pack forming operation in which insert blanks 3,4 are placed on the top and the side of cigarette packs as the packs are pushed into a package forming turret. The Draghetti operation lacks the temporary attachment of the blanks to the packs. The patents to Belcher and Focke teach the concept of electrostatic charging an insert and an article with electrodes 62 and 78 (see Figure 11), respectively, to temporarily attach the insert to the article so it would remain in place while the pack is further processed in the machine. It would have been obvious to one skilled in the art to temporarily attach the insert of Focke to the cigarette packs as shown by Belcher or Focke so the insert would remain in place while the pack is further processed in the machine.

Regarding claims 8 and 12, the location of the charge is a matter of desired choice and it would have been obvious to one skilled in the art to charge in any position on the insert and the article since no new or unexpected result would be achieved and the process/apparatus would perform equally well with the charge being placed in any position on the label or article.

Regarding claims 5-7 and 11 the use of inserts, coupons, labels, booklets etc. in cigarette packs, both of the type where the insert is inserted into a partially formed pack or on a hinge-lid-type pack with a collar, are well known in the art (see admitted prior art on page 1 of the specification) and modifying the process/apparatus of Belcher to accommodate such packs would have been obvious to one skilled in the art.

ADDITIONAL REFERENCES CITED

The cited prior art is made of record but has not been relied upon in the rejection of claims. However, the prior art is considered pertinent to applicant's disclosure.

The patents to Draghetti and Buckley show the application of inserts to cigarette packs.

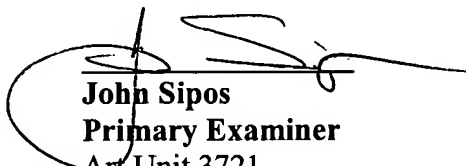
The other cited patents show the use of a static charge to hold an insert against an article.

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **(703) 308-1882**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for Group 3700 of the Patent and Trademark Office is **(703) 872-9306**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703) 308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-1148.


John Sipos
Primary Examiner
Art Unit 3721